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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,372	02/21/2002	Christian Kraft	367.41185X00	5016
22907	7590	07/26/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			PAPPAS, PETER	
			ART UNIT	PAPER NUMBER
			2628	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,372

Applicant(s)

KRAFT ET AL.

Examiner

Peter-Anthony Pappas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither

computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter (“...wherein the generating of the animation by editing... and successively displaying of said sequence of images... optimizes display resolution of the animation generated by the terminal”) which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Therefore, it is noted that one skilled in the art, at the time of the applicant’s invention, would have to perform undue experimentation to ascertain the criteria for defining an optimized display resolution. While the specification

does disclose a "selection border" option for cutting or selecting the part of the animation that he wants to save (p. 6, lines 11-18) said language fails to disclose the criteria for defining an optimized display resolution.

Claim Objections

5. Claims 1-19 are objected to because of the following informalities: lack of antecedent basis for the limitation "...the terminal". It is noted that the applicant indicated, in a telephonic interview held on 12/13/05, that a terminal referred to a wireless handheld communication device. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5, 8, 12, 15-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al. (U.S. Patent No. 5, 870, 683), in view of Kalra et al. (U.S. Patent No. 5, 953, 506).

8. In regards to claim 1 Wells et al. teaches a method for operating a wireless user terminal or mobile station (wireless handheld communication device), such as a cellular telephone (column 1, lines 52-67; column 2, lines 1-5), to selectively display a plurality of graphical information sequences (images which represent an animation) on a display of the wireless user terminal or mobile station (column 2, lines 13-25). Wells et al. teaches that the parameter *animation_parameter* is able to be passed to a given

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animation at run-time, in which the content of said parameter influences (edits) the final animation which is to be generated. For example, text characters used in an animation can be passed to the animation in an *animation_parameter* (column 5, lines 35-38; Figs. 3A-B). When refreshed a current animation scene or frame is replaced by a next consecutive frame or scene (column 4, lines 38-42). An animation is comprised of X number of discrete images displayed at intervals of Y ms, which are selectable or fixed values (column 9, lines 61-64). Wells et al. further teaches that an alerting animation can include a predetermined audio alerting indicator, such as a musical tone (column 9, lines 40-42).

Wells et al. fails to explicitly teach the optimization of display resolution of the animation generated by the terminal (wireless handheld communication device). Kalra et al. teaches that an object of the present invention to provide a method and apparatus for reproducing sounds and/or images with a resolution that is optimized to the capabilities of the client computer that is decoding previously encoded sounds and/or images (column 1, lines 66-67; column 2, lines 1-3). Kalra et al. further teaches that a profile can be further adapted to increase the resolution of certain characteristics, such as sound, at the expense of other characteristics, such as video (column 2, lines 46-49).

It would have been obvious to one skilled in the art, at the time of the applicant's invention, to incorporate the teachings of Kalra et al. into the method taught by Wells et al., because through such incorporation it would allow for said animation to be displayed at a resolution optimized to the capabilities of said mobile station (client computer), thus displaying said animation under the best available conditions while also allowing for said

user to increase the quality of said animation, i.e. visually, if they choose to sacrifice the quality for another property of said animation, i.e. such as said musical tone.

9. In regards to claim 5 the rationale disclosed in the rejection of claim 1 is incorporated herein (Kalra et al.: column 1, lines 66-67; column 2, lines 1-3).

10. In regards to claim 8 the rationale disclosed in the rejection of claim 1 is incorporated herein.

11. In regards to claim 12 the rationale disclosed in the rejection of claim 5 is incorporated herein.

12. In regards to claims 15 the rationale disclosed in the rejection of claim 1 is incorporated herein (Wells et al.: column 1, lines 52-67; column 2, lines 1-5).

13. In regards to claims 16 the rationale disclosed in the rejection of claim 1 is incorporated herein (Wells et al.: column 1, lines 52-67; column 2, lines 1-5).

14. In regards to claim 19 the rationale disclosed in the rejection of claim 1 is incorporated herein. Wells et al. further teaches a computer program product stored on a storage medium for execution by a processor for implementing said method (column 3, lines 17-21, 43-59).

15. Claims 2, 6-7, 9, 12-14 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al. (U.S. Patent No. 5, 870, 683) and Kalra et al. (U.S. Patent No. 5, 953, 506), as applied to claims 1, 5, 8, 12, 15-16 and 19, in view of Hawkins et al. (U.S. Patent No. 6, 516, 202 B1), and further in view of the GIF Construction Set Professional Manual, referred to herein as GCSPM, and the GIF Construction Set Professional Homepage, referred to herein as GCSPH. It is noted

GCSPM includes references to "Introductory and Tutorial" and "Reference", which are considered part of said GCSPM.

16. In regards to claim 2 Wells et al. fails to explicitly teach the number of times the display of the sequence of images is to be repeated is set by the user of a handheld communications device. Hawkins et al. teaches an organizer, which runs the Palm OS, with a cellular component that allows said organizer to be coupled to a plurality of telephones for different frequencies/standards (column 2, lines 19-38). GCSPM teaches an animation software application that has a loop command, which adds a "LOOP block" to a given animation. Said "LOOP block" has an iterations argument that defines the number of times said animation will loop (Reference, p. 34; Introductory Tutorial, p. 4).

Official Notice is taken that both the concept and the advantages of recognizing the need for additional processing resources, such as processing power, memory storage and display space, for cellular devices because typical cellular devices are considered limited in terms of hardware to the extent in which animation modification, storage and display can be performed via such a device are well known and expected in the art. Official Notice is taken that both the concept and the advantages of utilizing a typical organizer, such as one running the Palm OS, to provide greater processing, storage and display resources over that of typical cellular devices are well known and expected in the art. Official Notice is taken that both the concept and advantages of installing and executing a plurality of applications on a typical organizer, such as one running the Palm OS, in which said applications mimic or completely replicate those

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applications utilized by a conventional desktop machines are well known and expected in the art.

It would have been obvious to one skilled in the art, at the time of the applicant's invention, to utilize an organizer with a cellular component, as taught by Hawkins et al., as a means by which to attain said additional resources for the modification, storage and display of animation, because an organizer with a cellular component would provide the required additional resources in regards to processing power, memory storage and display space, thus allowing for a more robust user experience. Additionally, the incorporation of a cellular component would allow for the teachings of Well et al. to be fully implemented in said improved apparatus.

It would have been obvious to one skilled in the art, at the time of the applicant's invention, to incorporate additional conventional animation functions into the apparatus as taught by Hawkins et al., specifically in regards to modifying, storing and displaying animation, such as those conventional animation functions taught by GCSPM, because the restrictions imposed by a typical cellular device utilizing animation functions, as taught by Well et al., would be able to be overcome and thus would allow for a more advanced and complete animation experience than with the restrictions previously imposed.

17. In regards to claim 6 Wells et al. and Kalra et al. fail to explicitly teach wherein the user controls the resizing of only one of the images and the handheld communication device automatically resizes the remaining images.

GCSPM teaches that part or all of a given animation sequence, comprised of images, can be rotated, cropped, color-adjusted or resized (Homepage, p. 3). The Resize function allows for the modification of the size of one or more images in a GIF file (animation). This function only affects the selected blocks in the current document window. To apply it to all the blocks in a GIF file, click on the green "Tag All" button (Reference, p. 15, 30-31). It is noted that cropping is considered a form of resizing. GCSPM fails to explicitly teach resizing the images into a display size being specific for an application in the handheld communication device in which the animation has to be used.

It would have been obvious to one skilled in the art, at the time of the applicant's invention, to crop or resize images of a given animation, which when combined form a completed animation, respective to a desired display size for a given display device, because through such modifications better resolution of a given area of interest could be achieved thus enhancing the view ability of said animation when displayed on said display device in which part of said animation would not off screen or otherwise incomplete.

18. In regards to claim 7 the rationale disclosed in the rejection of claim 6 is incorporated herein.

19. In regards to claim 9 the rationale disclosed in the rejection of claim 2 is incorporated herein.

20. In regards to claim 13 the rationale disclosed in the rejection of claim 6 is incorporated herein. GCSPH teaches that animation operations are performed in a (picture viewer) window (Homepage, p. 3, Fig. 1).

21. In regards to claim 14 the rationale disclosed in the rejection of claim 7 is incorporated herein. GCSPH teaches that animation operations are performed in a (picture viewer) window (Homepage, p. 3, Fig. 1).

22. In regards to claim 17 Wells et al. teaches a user interface includes a conventional earphone or speaker 17, a conventional microphone 19, a display 20, and a user input device, typically a keypad 22, all of which are coupled to the controller 18 (column 3, lines 25-28). In regards to the speeding up and the slowing down of an animation (interval between animation images) the rationale disclosed in the rejection of claim 1 is incorporated herein. Additionally, GCSPM teaches a delay option which is defined as the number of hundredths of a second between images in an animation (Reference, p. 34). In regards to a loop setting the rationale disclosed in the rejection of claim 2 is incorporated herein.

In regards to resizing the rationale disclosed in the rejection of claim 6 is incorporated herein. It is noted GCSPM does not place a restrictions on the size of a given cropping rectangle (Reference, p. 15, 30-31).

Official Notice is taken that both the concept and advantages of cropping on a pixel by pixel basis, wherein for exmaple even a single pixel may be cropped, are well known and expected in the art. It would have been obvious to one skilled in the art, at the time of the applicant's invention, to incorporate the ability for single pixel cropping,

because through such incorporation one would be able to achieve greater flexibility and precision in terms of editing (cropping) a given image to match a desired objective.

GCSPM teaches plain text blocks include text which is displayed as part of your animation (Reference, p. 20). It is noted that each text or image elements added to a given animation is considered a block and that the movement and final arrangement of said blocks dictate the direction of the animation composed of said elements. It is also noted previously taught functions from the GCSPM are considered to have a corresponding menu dialog in the application.

In regards to optimizing display resolution the rationale disclosed in the rejection of claim 1 is incorporated herein.

23. In regards to claims 18 the rationale disclosed in the rejection of claim 17 is incorporated herein (Wells et al., column 1, lines 52-67; column 2, lines 1-5).

24. Claims 3-4 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al. (U.S. Patent No. 5, 870, 683), Kalra et al. (U.S. Patent No. 5, 953, 506), Hawkins et al. (U.S. Patent No. 6, 516, 202 B1), GCSPM and GCSPH, as applied to claims 2, 6-7, 9, 12-14 and 17-18, in view of applicant's admitted prior art, referred to herein as AAPA.

25. In regards to claim 3 Wells et al., Kalra et al., Hawkins et al., GCSPM and GCPH fail to explicitly disclose that if said number of times the display of the sequence of images is to be repeated exceeds said predetermined number, the handheld communication device only repeat the display sequence said predetermined number of times. However, as disclosed in rejection of claim 2 GCSPM does teach an animation

software application that has a loop command, which adds a "LOOP block" to a given animation. Said "LOOP block" has an iterations argument that defines the number of times said animation will loop (Reference, p. 34; Introductory Tutorial, p. 4). AAPA teaches a looping parameter specified by NETSCAPE 2.0, wherein a maximum 50 loops for a given animation are displayed (Specification, p. 8, Table 2).

It would have been obvious to one skilled in the art, at the time of the applicant's invention, to incorporate a means by which to interrupt the repetition of play of a given animation, as taught by AAPA, into the system taught by Wells et al., Hawkins et al., GCSPM and GCPH, which teaches setting a number of times said animation will loop, because through such incorporation it would allow for greater control over said animation (i.e. when to terminate said animation) and said control would be dictated by the software running said animation and not by the animation itself, thus allowing for said animation to loop infinitely or a limited number of times, all without having to have the animation itself changed accordingly.

26. In regards to claim 4 Wells et al. teaches the next time the user activates the Keyguard feature, the selected animation is automatically invoked, started and run by the controller 18 (column 8, lines 14-16).

27. In regards to claim 10 the rationale disclosed in the rejection of claim 3 is incorporated herein.

28. In regards to claim 11 the rationale disclosed in the rejection of claim 4 is incorporated herein.

Response to Arguments

29. In response to applicant's remarks in regards to the 35 U.S.C. 112 first paragraph rejection said remarks have been fully considered but are deemed not persuasive.

30. In response to applicant's remarks in regards to the lack of antecedent basis for the limitation "...the terminal" it is noted that said term has not been removed as was indicated in said remarks.

31. In response to applicants' remarks that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a user of the wireless handheld communication device to edit an image to optimize the display resolution) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Kalra et al. teaches that it is a further object of the present invention to provide a method and apparatus that allows for variation in resolution of different media forms so that the quality of a media form such as sound can be increased at the expense of the quality of another media form, such as picture image, according to the desires of the user (column 2, lines 18-23).

32. In response to applicant's remarks that nowhere in the '202 patent is the concept of allowing user to set the number of times the display of the sequence of images is to be repeated even suggested it is noted the '202 patent was not introduced to teach said

limitation. Said limitation is addressed by GCSPM. Applicant is directed to the respective rejection above.

33. In response to applicant's remarks that nowhere in the GCSPM is there any reference to a cellular phone it is noted that GCSPM was not introduced to teach said limitation. Said limitation is addressed by Wells et al. and Hawkins et al. Applicant is directed to the respective rejection above.

34. Applicant's remarks have been fully considered but are deemed not persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter-Anthony Pappas whose telephone number is 571-272-7646. The examiner can normally be reached on M-F 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peter-Anthony Pappas
Examiner
Art Unit 2628

PP


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